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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,020

05/12/2005

Mats Dahlback

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7590

11/26/2008

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EXAMINER

DUDNIKOV, VADIM

ART UNIT

PAPER NUMBER

3663

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/517,020	Applicant(s) DAHLBACK ET AL.	
	Examiner VADIM DUDNIKOV	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6,9-13,15,18 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,9-13,15,18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment filed 8/18/2008 forms the basis for this Office Action.

Claims 1, 10, 13, 22, 27 and 31 have been amended. Claims 2, 4-5, 7-8, 14, 16-17 and 19-20 are canceled. Claims 1, 3, 6, 9-13, 15, 18 and 21-33 have been pending.

Claims amendment overcome claim 1 and claim 13 rejections relating to wording “mainly” and claim 22 rejection relating to wording “suitable”. Said rejections are withdrawn.

Comments on Remarks submitted with said amendments are included below under Response to Arguments.

Response to Arguments

2. Applicant's arguments pages 6-8 filed 8/18/2007 have been fully considered but they are not in every respect persuasive. Those objections and rejections that have been overcome are omitted from the present Office Action and are considered withdrawn.

3. With regard to the Rejection under 35 U.S.C. § 112 Applicant's Argument on page 6, lines 20+ are not persuasive because describing and enablement of limitation of claim 1, line 10+: “impurities of a content that does not exceed that which is normally

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accepted in Zr or Zr-alloys for application in nuclear reactor” as disclosed in Specification is not correct .

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

One cannot rely on the Remarks in a Response to an Office action (or Amendment) to provide subject matter that the specification itself must recite for definiteness and for completeness.

4. With regard to the Rejection under 35 U.S.C. § 112 Applicant's Argument on page 7, lines 7+ is accepted as persuasive and said rejection is withdrawn.

Rejection of amended claims established in light of further consideration of Application and search of the prior Art. See rejections underneath.

Claim Rejections - 35 USC, 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims **1, 3, 6, 9-12, 13, 15, 18 and 21-33** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim **1** recites the limitation, "impurities of a content that does not exceed that which is normally accepted in Zr or Zr-alloys for applications in nuclear reactors." There is neither an adequate description nor enabling disclosure as to what is meant by the term, "normally accepted." For example, what is the standard for so-called normal acceptance, who sets this standard, etc.

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

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One cannot rely on the Remarks in a Response to an Office action (or Amendment) to provide subject matter that the specification itself must recite for definiteness and for completeness.

Claims **3, 6, 9-12, 13, 15, 18 and 21-33** are rejected as depended on rejected claim 1.

7. Claims **1, 3, 6, 9-12, 13, 15, 18 and 21-33** are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. In claim 1 a step, a “rolling” is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims **3, 6, 9-12, 13, 15, 18 and 21-33** are rejected as depended on rejected claim 1.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims **1, 3, 6, 9-12, 13, 15, 18 and 21-33** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim **1** is vague, indefinite and incomplete, and its metes and bounds cannot be determined because no criteria are provided on what constitutes normally accepted level of impurities in Zr or Zr-alloys for applications in nuclear reactors.

Claims **3, 6, 9-12, 13, 15, 18 and 21-33** are rejected as depended on rejected claim 1.

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10. Claims **1, 3, 6, 9-12, 13, 15, 18 and 21-33** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is: a “rolling” critical or essential to the practice of the invention, but not included in the claim. Claims **3, 6, 9-12, 13, 15, 18 and 21-33** are rejected as depended on rejected claim 1.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier

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communications from the examiner should be directed to Vadim Dudnikov whose telephone number is 571- 270-1325. The examiner can normally be reached on 8:00 - 17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached, Mon-Fri 7:00am-4:00 pm, at telephone number 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VD. 11/19/08.

/Rick Palabrica/

Primary Examiner, Art Unit 3663